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QM61/1223

EXAMINER	
WORRELL JR, L	
ART UNIT	PAPER NUMBER
3741	

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UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 11

12-23-98

Application Number: 08/863,113

Filing Date: 05/27/97

Appellant(s): GOINEAU et al.

Earle R. Marden
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 9/14/98.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

Initially it should be noted that appellant has titled the summary of the invention as "STATUS OF THE INVENTION". The summary of invention contained in the brief is deficient because initially in line 1 of the summary of the invention the characterization of the yarn as "single ply yarn" is not part of the description as originally filed and therefor does not summarize the originally disclosed invention. Additionally, in line 7 of the summary of the invention the characterization of the invention as "without further processing" is not part of the application as originally filed and therefor does not summarize the originally disclosed invention.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 11-18 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). Therefor claim 11 stands

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or falls by itself. Claims 12-14 stand or fall together. Claims 15 and 16 stand or fall together.

Claims 17 and 18 stand or fall together.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

✓ 5,172,459	GOINEAU	12-92
✓ 4,043,010	GORRAFA	8-1977

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 11-18 are rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in prior Office action, Paper No. 8.

Claims 11-16 are rejected under 35 U.S.C. 112, second paragraph. This rejection is set forth in prior Office action, Paper No. 8.

Claims 11-18 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office action, Paper No. 8.

(11) *Response to Argument*

Initially on page 3 of the brief appellant argues that the 255 denier, 34 filament yarn is indicative of a single ply yarn. No where in the specification as originally filed is it explicitly

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stated that the yarn is a "single ply". Thus the specification is unclear as to whether the 255 denier, 34 filament yarn is single ply, double ply or triple ply. The term "single ply" has never been set forth in the original specification as being a requirement in the methodology of the invention and therefor the inclusion of such language within the claims is improper under 35 U.S.C. 112, first paragraph.

In the final paragraph of page 3 of the brief appellant argues that the phrase "without further processing" finds support in the specification as originally filed. The examiner disagrees. No where in the specification as originally filed is it stated or implied that the process includes supplying the yarn directly to the take-up roll "without further processing". On the contrary, as clearly seen in the figures 1 and 2 the yarn is fed through a dancer roll and is tensioned. This is ~~is~~ self-evidently further processing of the yarn since tension is placed on the yarn. Applicant's preclusion of any further processing by the statement "without further processing" is new matter since no where within the original specification is it stated that further processing should not take place. To avoid further processing has never been stated as being a critical part of the invention. Moreover, it has never been set forth as being any part of the invention. Since the characterization of "without further processing" has never been set forth in the original specification as being a requirement in the methodology of the invention the inclusion of such language within the claims is improper under 35 U.S.C. 112, first paragraph.

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On page 4, paragraph 1 of the brief, appellant states that the rejection of claims 11-18 under 35 U.S.C. 112, second paragraph does not now apply since claim 11 has been amended to correct an obvious omission. However, no after final amendment correcting such omission has been filed and therefor the rejection remains proper.

On page 4, paragraphs 2 and 3 of the brief, appellant argues that Goineau(5172459) does not anticipate the claimed process. Initially it should be noted that the rejection before the board is based on an obvious type rejection not anticipation. The prior art of Goineau(5172459) teaches the process as claimed including providing a bobbin of polyester POY multi-filament synthetic yarn(20, 26, 24), supplying said yarn to a heater(32), drawing said yarn in a draw zone with a draw ratio in the range of 1.8-2.3(column 2, lines 24-27) as it passes over the heater to fully orient the yarn and taking up the fully oriented yarn(42). The only portion of claims 11 and 15 Goineau(5172459) does not teach are those recitations which do not find support in the application as originally filed, i.e. "single ply" and "without further processing". Even so, it is the examiner's opinion that it would have been obvious to provide the process of Goineau(5172459) with a single ply yarn material rather than a multiply yarn material so that a single ply POY can be drawn and fully oriented as shown by Goineau(5172459). Additionally, it would have been obvious at the time the invention was made to one of ordinary skill in the art to provide the oriented yarn directly to a take up roll without further processing in order to provide a non-textured fully oriented yarn rather than a textured yarn. The use of a single ply instead of a multiply is merely a change in material and would bring about exactly what

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one of ordinary skill in the art would expect, i.e. a fully drawn and oriented single ply yarn.

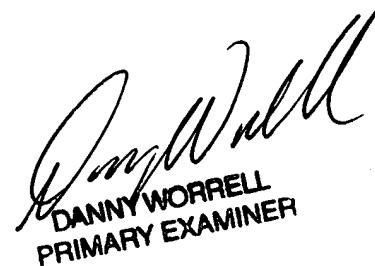
Additionally, the removal of the air texturing process from Goineau(5172459) brings about what one of ordinary skill in the art would expect, i.e. a non-textured, fully drawn and oriented yarn.

Absolutely no unexpected results arise from using a "single ply yarn" or "without further processing". No where within the original specification has applicant attached any significance to a "single ply yarn" or "without further processing". Moreover, neither "single ply yarn" or "without further processing" are even set forth within the original specification.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

LDW
December 21, 1998



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